

REMARKS

Claims 1 to 8 are currently pending in the present application.

In view of this response, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph two (2) of the Office Action, claims 1 to 8 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

As an initial matter, it is respectfully submitted that the Office Action does not set forth a *prima facie* case of unpatentability. The office bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). As stated in M.P.E.P. § 2106, “if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation” (emphasis added).

The Office Action merely states that “[i]n order for claims to be statutory, claims must include a practical application with a concrete, useful, and tangible result. However, claims 1-8 merely disclose elements/steps of performing mathematical function without disclosing a practical application with a concrete, useful, and tangible result, as they are pre-emptive in any application.” (Office Action, p. 2 (emphasis in original)). The guidelines, however, specifically state that “[a] claimed invention is directed to a practical application of a 35 U.S.C. 101 judicial exception when it: (A) ‘transforms’ an article or physical object to a different state or thing; or (B) otherwise produces a useful, concrete and tangible result, based on the factors discussed below.” M.P.E.P. 2106 (emphasis added). These are two separate tests, each of which will alone demonstrate a practical application of a 35 U.S.C. § 101 judicial exception.

It is respectfully submitted that claims 1 and 6 provide a physical transform. Claim 1 recites, in relevant part, “**applying** a control signal to a correction device connected between at least one of the two comparing devices and a logic device” and “**gating** the two intermediate comparison results in the logic device, depending on the control signal applied to the correction device, wherein an output of the logic device is provided as an overall result.” Claim 6 recites similar features to those of claim 1. Applying the control signal to the correction device transforms the correction device by opening and closing electrical gates within the correction device. Furthermore, gating the logic device transforms the logic

device by opening and closing electrical gates within the logic device to provide the overall result.

Separately, claims 1 and 6 provide a useful, concrete and tangible result. M.P.E.P. § 2106 further states “abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods . . . employing abstract ideas, natural phenomena, and laws of nature to **perform a real-world function may well be**” (emphasis added). The method according to claims 1 and 6 produces a useful, concrete and tangible result to constitute a practical application of an abstract idea, law of nature or natural phenomena. As stated in M.P.E.P. § 2106, “the focus is not whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved . . . is ‘useful, tangible, and concrete.’”

For a claim to be “useful,” it must satisfy the utility requirement, i.e., specific, substantial and credible utility must be provided. As explained above, it is the Office’s burden to present a *prima facie* case of unpatentability. There is nothing in the record to indicate or suggest whether or why claims 1 and 6 may be considered to not satisfy the utility requirement. It is respectfully submitted that a comparison result produced by claims 1 and 6 is a useful result and may be used in at least one practical application, described below.

For a claim to satisfy the “tangible” requirement, the claim must set forth a practical application of that judicial exception to produce a real-world result. There is nothing in the record to indicate or suggest whether or why claims 1 and 6 do not satisfy the tangible requirement. It is respectfully submitted that a comparison result as recited in claims 1 and 6 has at least one practical application: providing situation-dependent error-handling.

For a claim to satisfy the “concrete” requirement, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. There is nothing in the record to indicate or suggest whether or why claims 1 and 6 do not satisfy the concrete requirement. It is respectfully submitted that, given the same inputs, claims 1 and 6 will produce the same result in a repeatable manner.

Accordingly, based on the analysis set forth in M.P.E.P. § 2106, it is plainly apparent that claims 1 and 6 constitute eligible subject matter.

Still further, while the rejections may not be agreed with, to facilitate matters, claim 1 has been rewritten to include the feature in which the overall result is usable for situation-dependent handling in a vehicle system. The Specification provides, for example, support for

this feature at page 2, lines 25 to 35. It is respectfully submitted that this additional feature clearly discloses a practical application with a concrete, useful, and tangible result.

Accordingly, claim 1, as presented, is directed to statutory subject matter.

Claims 2 to 5 depend from claim 1, as presented, and are therefore allowable for at least the same reasons as claim 1.

Claim 6, as presented, recites features similar to those of claim 1, as presented, and is therefore allowable for at least the same reasons provided as to claim 1. Claims 7 and 8 depend from claim 6, as presented, and are therefore allowable for at least the same reasons as claim 6.

Withdrawal of this rejection to the claims is therefore respectfully requested.

In summary, claims 1 to 8 are allowable.

CONCLUSION

In view of the foregoing, all pending claims 1 to 8 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,

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